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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,686	07/15/2003	Karim Boumediene	065691-0293	8450

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EXAMINER	
JAGOE, DONNA A	

ART UNIT	PAPER NUMBER
1614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/619,686	BOUMEDIENE ET AL.	
	Examiner	Art Unit	
	Donna Jagoe	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-66* is/are pending in the application.

4a) Of the above claim(s) *51,52,61-64 and 66* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-50,53-60 and 65* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/21/03 and 2/20/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 41-50, 53-60 and 65 drawn to a cosmetic composition and method of making said cosmetic composition in the reply filed on November 6, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 51, 52, 61-64 and 65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Newly submitted claim 66 directed to an invention that is independent or distinct from the invention originally elected for the following reasons: claim 66, dependent on cancelled claim 1, further comprises components that were non elected in the restriction dated October 6, 2006. Accordingly, claim 66 is withdrawn from consideration as being directed to a non-elected invention.

Claims 41-50, 53-60 and 65 are presented for examination.

Priority

Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 09/868989 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the

requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

Information Disclosure Statement

The information disclosure statement filed October 21, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The items listed as A6-A9 do not have a copy present in the application. Further, the items listed as A15 and A16 do not include a date for publication. It has been placed in the application file, but the information referred to therein has not been considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 44 and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

Applicant has not conveyed possession of the invention with reasonable clarity to one skilled in the art. In particular, Applicant has not provided a description of the structure of a representative number of compounds which are an "unsaponifiable fractions of avocado oil enriched with furan derivatives" and "unsaponifiable fractions of avocado oil enriched with polyhydroxylated fatty alcohol derivatives". Further, applicant has not provided a description of the chemical and/or physical characteristics of a representative number of such compounds nor a description of how to obtain a representative number of said specific compounds.

To satisfy the written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date, that applicant was in possession of the claimed invention. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., Fujikawa v. Wattanasin, 93 F.3d 1559, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) (a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would

not "reasonably lead" those skilled in the art to any particular species); In re Ruschig, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 44-45, the phrase "furan derivatives (fraction H)" and the phrase "fatty alcohols (fraction I)" renders the claim indefinite because it is unclear whether the limitation(s) following the parentheses are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 41-46, 48, 49, 50, 55, 59 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Guillon U.S. Patent No. 4,386,067.

Guillon teaches a cosmetic composition comprising unsaponifiable components of avocado oil and soya bean oil (column 2, lines 39-52 and column 2, lines 57-61). Guillon teaches that the fatty acid content of the unsaponifiable oils can be identified as having vegetable sterols and tocopherols (column 1,

lines 41-66). Regarding the fraction H and fraction I, in the unsaponifiable component of avocado oil, and the 40 to 65% sterols and greater than 10% tocopherols, "Products of identical chemical composition (i.e. the unsaponifiable component of avocado oil) can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims (i.e. the presence of at least a fraction enriched with furan derivateves and at least a fraction enriched with polyhydroxylated fatty alcohols or mixtures of these two fractions) are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (Applicant argued that the claimed composition was a pressure sensitive adhesive containing a tacky polymer while the product of the reference was hard and abrasion resistant. "The Board correctly found that the virtual identity of monomers and procedures sufficed to support a prima facie case of unpatentability of Spada's polymer latexes for lack of novelty."). The compositions of example 2 and 3 have 0.3% unsaponifiable component of avocado oil and soya bean oil (ex. 2) and 1.05% unsaponifiable component of avocado oil and soya bean oil (ex 3) thus it is within the bounds of claims 49 and 50, drawn to an amount of unsaponifiable component of avocado oil and soya bean oil from about 0.1% to about 10%. Guillon teaches that the unsaponifiable component comprises phytosterols, tocopherols (column 1, lines 41-66). Methods are disclosed for "post solar creams" (post actinic ray exposure of claims 55 and 59). Claim 65 drawn to the method of preparing the cosmetic composition is anticipated by the compositions

in examples 2 and 3 (columns 5-6) where non-saponifiable fraction of avocado oil is combined with non-saponifiable soya bean oil is combined with a cosmetically acceptable vehicle for application to the skin (dry skin or make-up remover for the skin). The method of obtaining the unsaponifiable portion is well-known in the art as stated in column 5, lines 4-10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 47, 53, 54, 56-58 and 60are rejected under 35 U.S.C. 103(a) as being unpatentable over Rancurel U.S. Patent No. 5,498,411 A. and Guillon U.S. Patent No. 4,386,067

Rancurel teaches a composition comprising a fraction H component in amounts ranging from 2 to 7% (column 1, lines 49-52). Rancurel et al. further teach that in nature, soy bean oil has about 1% fraction H thereby teaching that the claimed ratio of fraction H in avocado and soy bean oil is within the claimed ratio of about 0.1 to about 9. Methods are disclosed for treatment of the onset of skin aging (column 1, lines 31-38). It is noted that the composition does not teach the addition of soya bean oil. In this case, both the references identify the common problem of skin treatments with unsaponifiable vegetable oils and since one reference gives a specific example of a single critical parameter, Rancurel teaches that unsaponifiable avocado oil treats the onset of skin aging, and provides explicit guidance tying that parameter to key parameters of the second reference, Guillon et al. treating/moisturizing skin by employing unsaponifiable avocado oil and unsaponifiable soya bean oil, both vegetable oils to overcome the problem of skin aging. It is therefore reasonable to conclude that the strength of correlation between references gives rise to reasonable expectation of success from combining them.

Regarding claims 53, 56, 57 and 60 drawn to treatment of scars and depilatory treatment, Guillon teaches the composition of unsaponifiable avocado oil and unsaponifiable soya bean oil for skin treatments. Rancurel teaches that unsaponifiable avocado oil treats the onset of skin aging. Since the method of treatment of scars and the method of cosmetic depilatory treatment only requires an application to the skin, the prior art renders the claims obvious. It is not claimed that the skin has a scar or the skin is hirsute. It is therefore reasonable to conclude that the strength of correlation between references gives rise to reasonable expectation of success from combining them.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Thursday from 9:00 A.M. - 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Donna Jagoe
Patent Examiner
Art Unit 1614

May 7, 2007

5/14/07

ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER